

REMARKS**Drawings**

A. Turning now to the Office Action, the Examiner objected to the drawings, stating that trademarks and trade names should not be used.

5

The use of trademarks and trade names in the drawings were used as non-limiting examples and were for illustrative purposes only. The drawings have been amended to remove the use of trademarks and trade names. Therefore, the Applicant respectfully requests that the Examiner accept the proposed replacement drawings and withdraw this

10 objection.

Claim Rejections – 35 U.S.C. §102(b)

B. Claims 1, 2, 5, 6 and 8-11 were rejected under 35 U.S.C. 102(b) as being anticipated by Schutten (U.S. 6,575,297), hereinafter referred to as “Schutten.”

15

Regarding Claims 1, 2, 5, 6, and 8-11, the Examiner stated that Schutten discloses an illustrative drug card comprising an illustrative portion and a visually aided instruction. The Examiner further stated that the display is foldable and that the illustrative portion includes a pouch for medication. The Examiner also stated that symbols indicate when medication is to be administered, with Figure 2 showing where symbols regarding what food to administer with the medication may be recorded. The Examiner further stated that allergies and contact information are also included.

20

Nowhere in Schutten is there a visually-aided instruction. Schutten provides a “written guide portion 14” that allows a user to “write” instructions pertaining to a particular patient. (See Schutten, Col. 3) (Emphasis added). As such, the instructions in Schutten are textually-aided, not visually-aided as are cards made according to the present invention. The advantage to the present invention of Schutten is that it aids in removing literacy issues involved with medication. With the Schutten, a user must first be able to write instructions upon the drug card, and second, be able to read those

instructions. Schutten is to be contrasted with the present invention where a substantial portion of the medication information is illustrated through drawings and symbols.

Through the use of drawings and symbols, a user is less likely to become confused with the text, as may be the case in Schutten.

5

Furthermore, nowhere in Schutten is the fold-ability of the drug card discussed. The drug card in Shutten is specifically designed to have a plurality of pouches where a plurality of pills are placed, with the Schutten invention thereafter being placed into a binder. (See Schutten, Col. 3). The Schutten invention would not fold as applicable to 10 the present invention because of the plurality of pills and pockets. Should a user try to fold the Schutten invention, the plurality of pockets with their included pills would prevent the drug card from being folded into a substantially planar form. As such, the drug card of Schutten is not foldable as are cards according to the present invention.

15

Nowhere in Schutten are there symbols indicating when medicine is to be delivered. The Examiner points to the abbreviations, A.M. and P.M. as symbols. However, A.M. and P.M. are abbreviations used to specify the hour, whereas a symbol is something that represents something else by association. *The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton 20 Mifflin Company.* Schutten is to be contrasted with the present invention, where actual symbols are used. For example, an illustration of a moon is used to symbolize the evening.

25

Furthermore, nowhere in Figure 2 of Schutten can be seen symbols representing what to administer with the medication. Although Figure 2 includes a blank space, the blank space is for “writ[ing] a description of each pill...” (See Schutten, Col. 3, lines 40-42) (Emphasis added). A blank space alone is not to be considered a symbol. Furthermore, and as discussed previously, although Schutten discloses writing a textual description in the blank space, an illustrative symbol is not to be confused with text. As

such, Schutten does not disclose symbols representing what to administer with the medication as does the present invention.

Regarding Claim 1, as Schutten does not teach all of the claimed limitations in

5 Claim 1, the Applicant believes that Claim 1 is allowable. Regarding Claims 2, 5, 6, and 8-11, the Applicant refers the Examiner to the comments above regarding Claim 1. As Schutten does not teach all of the claimed limitations in Claim 1, the Applicant believes that Claims 2, 5, 6 and 8-11, which depend partially therefrom, are also allowable for at least the same reasons. Thus, the Applicant respectfully requests that this rejection be

10 withdrawn.

Claim Rejections – 35 U.S.C. §103(a)

C. Claims 4, 7, 12, and 14-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shutten.

15 The four factors relevant to determining obviousness are: 1) the scope and content of the prior art, 2) the differences between the prior art and the Claims at issue, 3) the level of ordinary skill in the art when the invention was made, and 4) secondary indicia, such as commercial success and copying. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 86 S.Ct. 684, 694, 15 L.Ed.2d 545 (1966). In addition, an examiner addressing

20 obviousness must not take a "piecemeal approach, one in which [the examiner] takes the individual elements, item by item, and tries to show us that they each exist somewhere in the prior art. 'That all elements of an invention may have been old (the normal situation), some old and some new, or all new, is ... simply irrelevant.' " *Litton Systems*, 728 F.2d at 1443 (quoting *Environmental Designs Ltd. v. Union Oil Co. of California*, 713 F.2d 693,

25 698 (Fed.Cir.1983)); *see also Avia*, 853 F.2d at 1564 ("That some components of [the challenged patent] exist in prior art references is not determinative. '[I]f the combined teachings suggest only components of the Claimed design but not its overall appearance, a rejection under section 103 is inappropriate.' ") (quoting *In re Cho*, 813 F.2d 378, 382 (Fed.Cir.1987)).

Regarding Claims 4, 7, 12, and 14-21, the Examiner stated that Schutten does not specifically teach a picture of the medication, however, this is considered to be an equivalent alternative. The Examiner concluded that it would have been obvious to one of ordinary skill in the art to show a picture of the medication instead of a sample as an
5 alternate way of portraying the medication.

The Examiner further stated that Schutten does not particularly teach the symbols or drug interactions as being shown; however, this is considered to be a matter of design choice. The Examiner concluded that it would have been obvious to one of
10 ordinary skill to display whatever information is deemed necessary for the patient. The Examiner went on to state that patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. The Examiner concluded that the device of Schutten shows a medical information guide and that specific words or symbols used thereon cannot be relied on
15 for patentability.

In order to present a *prima facie* case of obviousness, the Examiner must provide
(1) one or more references (2) that were available to the inventor and (3) that teach (4) a
suggestion to combine or modify the references, (5) the combination or modification of
20 which would appear to be sufficient to have made the claimed invention obvious to one
of ordinary skill in the art.

Although the Examiner provided the Applicant with a reference, the reference
does not teach a suggestion to modify the reference. Nowhere in Schutten can be found
25 any reference for a medication guide using illustrative symbols as is applicable to the
present invention. The Examiner contends that the use of specific symbols is a design
choice and therefore not patentable, but cites no authority for such contention.
Furthermore, the present invention uses the symbols in a functional manner, not as a
mere design choice. Under 35 U.S.C. §101, “Whoever invents any new and useful

process, machine, or manufacture, or composition of matter may obtain a patent therefore..." (Emphasis added). For example, if a color-coded medication system was devised where medications of similar colors could be taken together, whereas medications at opposite ends of the color spectrum could not be taken together, the use 5 of colors would be functional. In such an example, a blue pill would not be a mere design choice, but would have a functional significance (i.e., be useful) and would therefore be patentable. Applying this analogy to the present invention, the symbols are not mere designs, but provide a user with very specific information as to how the medication should be administered and therefore have a functional use and are useful 10 within the meaning of §101. Accordingly, specific symbols such as a sun, a moon, stars, food, and liquid have a functional significance and are therefore patentable.

Regarding Claims 4, 7, 12, and 14-21, the Applicant refers the Examiner to the comments above regarding Claim 1. As Schutten does not teach all of the claimed 15 limitations in Claim 1, the Applicant believes that Claims 4, 7, 12, and 14-21, which depend partially therefrom, are also allowable. Thus, the Applicant respectfully requests that this rejection be withdrawn.

D. Claims 3, 23-20, and 32-39 were rejected under 35 U.S.C. 103(a) as being 20 unpatentable over Schutten as applied to Claim 1, and further in view of Stern (U.S. 4,310,978).

Regarding Claims 3, 23-20, and 32-39, the Examiner stated that Schutten does not teach the card as being magnetic, however, this is well known in the art of cards. 25 The Examiner stated that Stern teaches an information card including a magnetic layer (Figure 4) and that it would have been obvious to utilize the magnetic layer in the device of Schutten so that the card may be displayed on a magnetic surface where it may be more easily seen.

The Applicant asserts that the Examiner has misinterpreted the significance of Schutten. Schutten was specifically devised such that it can contain an index of medications to be included in "...every popular size of binder." (See Schutten, Col. 3, lines 8-9). A main idea behind Schutten is that it reduces stiffness and bulk, and can be maintained in "...an easily indexed form." (See Schutten, Col. 2, lines 15-19). Because the Schutten patent has been devised to reduce bulk by being placed in a binder to maintain an index, the present invention expressly teaches against the combination of Schutten with a magnetic backing. Combining Schutten with the Stern invention would result in a drug card with increased stiffness and bulk, and would resist being maintained in an index. The magnetic properties of the backing would create pages of drug cards that would either attract or repel between themselves and/or the binder's binding.

Because Schutten expressly states that it is disadvantageous to create a drug card that is stiff and bulky and that it would be desirable to maintain a plurality of drug cards in a single index, Schutten provides no suggestion to create a drug card with a magnetic backing and, in fact, teaches against such a feature.

For reasons stated above, a combination of Schutten with Stern does not teach all of the limitations of the present application. Also, even if the combination did teach the present application, the references must include a suggestion to combine or modify the references to arrive at the claimed invention, which they do not. In fact, the references expressly teach against such a combination or modification.

Furthermore, improvements in a prior art area are patentable. The court stated that "like many inventions, the new design is not an astonishing breakthrough or a new technology. Nevertheless, it is a significant non-obvious improvement on prior art. Sometimes achievement is revolutionary, but more often an inventor begins where others leave off and perceives the vital forward step to which predecessors have been blind. The courts must take care to not conclude that an innovation is obvious because it has become obvious by hindsight." *Berkely Park Clothes, Inc. v. Firma Shaeffer-Homberg GMBH*,

217 U.S.P.Q. 388, U.S. District Court, New Jersey (1981). The patent at issue in *Berkely*, U.S. Patent No. 3,872,554, is a closure for clothing in an area of crowded prior art. The court addressed the crowded art issue specifically, stating that “the field is a crowded field. It is an old field..... The non-obviousness is, I think shown rather dramatically by the rather surprising list of earlier patents of closures of this type, none of which approach this one in its conception.” See *Berkely* (emphasis added).

As was the case in *Berkely*, the present improvement is not revolutionary, but a significant non-obvious improvement on prior art. Showing prior art, the Examiner here used three references and made nine other references of prior art of the record. As in the case of *Berkely*, the present application is in a crowded field, where the non-obviousness can be shown by the rather surprising list of earlier patents, none of which approach the present application in its conception. Accordingly, the present invention is non-obvious as evidenced by the large number of prior art references.

15

In conclusion, the present invention is non-obvious because (1) the references cited by the Examiner do not include a suggestion to combine or modify the references to arrive at the claimed invention, and (2) the non-obviousness is shown by the surprisingly lengthy list of prior art which does not contain the present invention. Therefore, the Applicant respectfully requests that the Examiner withdraw this rejection of Claims 3, 23-20, and 32-39.

E. Claims 13 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schutten as applied to Claim 1, and further in view of Will (U.S. 4,593,819), hereinafter referred to as Will.

Regarding Claims 13 and 22, the Examiner stated that Schutten does not teach the inclusion of Braille, however, this is well known in the art. The Examiner further stated that Will teaches a medical chart having Braille thereon and that it would have been obvious to one of ordinary skill to utilize Braille on the device of Schutten so that visually-impaired patients may use the card.

Regarding Claims 13 and 22, the Applicant refers the Examiner to the comments above regarding Claim 1. As Schutten does not teach all of the claimed limitations in Claim 1, the Applicant believes that Claims 13 and 22, which depend partially therefrom, are also allowable, for at least those reasons. Thus, the Applicant respectfully

5 requests that this rejection be withdrawn.

F. Claims 31 and 40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shutten as applied to Claim 1, and in further view of Stern and Will.

10 Regarding Claims 31 and 40, the Examiner stated that it would have been obvious to one of ordinary skill to utilize Braille on the magnetic card for the same reasons as described above.

15 Regarding Claims 31 and 40, the Applicant refers the Examiner to the comments above regarding Claim 1. As Schutten does not teach all of the claimed limitations in Claim 1, the Applicant believes that Claims 31 and 40, which depend partially therefrom, are also allowable, for at least those reasons. Thus, the Applicant respectfully requests that this rejection be withdrawn.

Concluding Remarks:

The Applicant respectfully submits that in light of the above comments and remarks, all Claims are now in allowable condition. The Applicant thus respectfully requests timely allowance of all of the pending Claims.

5

In the event the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either Applicant or Applicant's representative would be beneficial the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

10

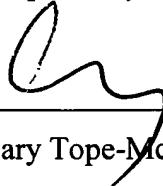
The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-2691. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of 15 the number of months necessary to make this response timely filed. The petition fee due in connection therewith may be charged to deposit account no. 50-2691.

Date:

20

10/6/04

Respectfully submitted,



Cary Tope-McKay

Registration No. 41,350

Tope-McKay & Associates

25 23852 Pacific Coast Highway, #311

Malibu, CA 90265

310.589.8158 ph

310.943.2736 fax

cmckay@topemckay.com

30